

Remarks

Claims 2, 4, 6 and 9-14 have been cancelled without prejudice.

Claims 1 and 3 are presently amended. **Claims 1-14 have been rejected.**

The Examiner has objected to claims 1-14 because language regarding the "user having arms having hands" in claim 1 and the narrative language regarding the user in the other claims does not add any patentable weight to the claims. Claims 1 and 3 have been presently amended to correct this informality, and claims 2 and 9-14 have been cancelled, thus the Examiner's objection has been obviated.

The Examiner has rejected claim 8 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that claim 8 recites the limitation "the elongated strip" in line 2, and that there is insufficient antecedent basis for this limitation in the claim. This rejection is respectfully but strenuously traversed for the reasons set forth in detail below.

Claim 8 is indirectly dependant upon claim 1. Claim 1 recites, on line 9, a sanding attachment "comprising an elongated strip of metal." Herein is found the proper antecedent basis for the rejected recitation in claim 8, therefore the Examiner's rejection has been successfully traversed.

Reconsideration and withdrawal of this rejection is respectfully requested.

The Examiner has rejected claims 1, 2 and 14 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,914,906 to Barnes ("Barnes"). Specifically, the Examiner states that Barnes discloses all of the limitations of claims 1 and 14, i.e., a sanding attachment comprising an elongated strip of metal (blade 25); an attachment end (28); a sanding end having a sanding strip (27); and at least one bend, Fig. 14. The Examiner states, regarding claims 2 and 14, Barnes meets the limitations, i.e., the bend having sufficient angle, and, e.g., vertically lowering the tool, removing the attachment and storing all inherent.

The Examiner has rejected claims 1-3 and 14 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,149,510 to Romagnoli ("Romagnoli"). Specifically, the Examiner states

Romagnoli discloses all of the limitations of claims 1 and 14, i.e., a sanding attachment comprising an elongated strip of metal (10); an attachment end (20); top and bottom surfaces (38, 24); a sanding end having a sanding strip (22); and at least one bend, (either notch 58, defining two bends or acute angle defined by 37). Regarding claims 2 and 3, the Examiner states that Romagnoli meets the limitations, i.e., the bend having sufficient angle; bends 58 and 37; sanding strip. These rejections are respectfully but strenuously traversed for the reasons set forth in detail below.

Prior art is anticipatory if it explicitly or inherently discloses every limitation recited in the claims (M.P.E.P. 2131.05 [R-2]). In order for prior art to anticipate a claim of an application, *every single element* of that claim must be disclosed within a single source.

The rejection of claim 1 as being anticipated by Barnes fails to satisfy this criterion. Barnes discloses a sanding blade that includes an abrasive sheet material 49 juxtaposed to the blade via a removable, pressure-sensitive adhesive backing so that when it is used up, it can be simply peeled off the blade and replaced (col. 3, lines 51-62). By comparison, the present invention is

patently distinct in that the sanding strips 12P are constructed of a durable metal, not an abrasive sheet material. Furthermore, the sanding strip of the present invention is not meant to be removed from the bottom surface 12B of the sanding end 12S, unlike the removable adhesive backing disclosed in Barnes. This is further evidenced by the need to change the sanding attachment of the present invention depending on the level of abrasion desired. The invention in Barnes does not require a different attachment, it instead requires removing the adhesively-joined abrasive sheet material and applying a new sheet to the blade.

For the foregoing reasons, the Barnes patent does not explicitly or inherently discloses every limitation recited in the claims of the present invention, therefore a rejection under 35 U.S.C. 102(b) is improper. Specifically, Barnes fails to disclose a sanding attachment including a sanding strip comprised of non-removable metal, including small, raised protuberances.

Similarly, claim 1 is not anticipated by Romagnoli. Romagnoli discloses a blade which can alternately consist of a toothed blade (claim 16) or an abrasive (claim 17). However, while the abrasive in Romagnoli may include carbide steel granules (claim 18), the design of the blade allows only a small relative area of the blade to be composed of abrasive material (64 Romagnoli Figs. 1, 3).

Conversely, the claimed invention allows for a large surface area of abrasive material to be in contact with the surface to be abraded (12P Figs. 1, 2). Furthermore, the clearance notch 58 and portion forming an acute angle 37 are not the same limitation as the at least one bend of the claimed invention. The clearance notch 58 is provided to prevent the blade from interfering with the reciprocating saw (col. 3, lines 24-28), not to allow access to hard-to-reach areas. The portion forming an acute angle 37 of Romagnoli is very limited in that the angle is restricted to being parallel to the leading end 26 (col. 3, lines 43-45). While this feature may allow some difference in orientation of the blade relative to the abutting surface through the vertical plane (col. 3, lines 45-48), the one or more bends of the present invention are far superior, in that the bends allow the orientation to vary in multiple planes (i.e. vertical, horizontal and diagonal) at once, thus allowing a user to abrade hard to reach areas. For the foregoing reasons, the Romagnoli patent does not explicitly or inherently discloses every limitation recited in the claimed invention, therefore a rejection under 35 U.S.C. 102(b) is improper. Specifically, Romagnoli fails to disclose an improved sanding attachment including one or more bends, allowing greater variation in the orientation of the sanding end relative to the abutting surface.

Similarly, claim 3 of the claimed invention is not anticipated by Romagnoli. The clearance notch 58 of Romagnoli is meant to prevent interference of the blade 10 with any part of the reciprocating saw 12 while in use (col. 3, lines 25-28). The bends of the claimed invention, conversely, are meant to allow access to hard-to-reach areas. For the same reasons as discussed regarding claim 1, the portion 37 adjacent to the leading end which is substantially straight, of the Romagnoli patent, is a limitation distinct from the two bends of claim 3 of the claimed invention. For these reasons, Romagnoli does not teach or imply every element of the claimed invention, thus a rejection under 35 U.S.C. 102(b) is improper. Specifically, Romagnoli does not teach or imply a sanding attachment having two bends, wherein the net result of the two bends is that the attachment end and the sanding end are substantially mutually perpendicular to one another.

Claims 2 and 14 have been cancelled, thus the Examiner's rejection has been obviated.

Reconsideration and withdrawal of these rejections are respectfully requested.

The Examiner has rejected claims 3-13 under 35 U.S.C. 103(a) as being unpatentable over Barnes in view of U.S. Patent No. 4,707,947 to Harris ("Harris"). These rejections are respectfully but strenuously traversed for the reasons set forth in detail below.

In general, three basic criteria must be satisfied in order to establish a prima facie case of obviousness (M.P.E.P. § 706.02(j)). First, the reference or combination of references must teach or suggest all of the claim limitations. Second, there must be reasonable expectation of success. Third, there must be some suggestion of motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. The rejection of claims 3-13 based upon Barnes in view of Harris fail to satisfy the first criteria of a prima facie showing of obviousness.

Specifically, claim 3 is rejected because the Examiner states Barnes meets all of the limitations of that claim, except an attachment end, which is perpendicular to the sanding end. The Examiner states Harris teaches sanding attachment including

embodiments wherein the attachment end is perpendicular to the rest of the blade, Fig. 1.

Regarding claim 3, even the hypothetical combination of Barnes and Harris does not teach every limitation of the claimed invention. Specifically, they fail to disclose or imply a sanding attachment having two bends, which rotates the sanding end in the plane parallel to the attachment end. The specification and claims of Harris discusses supporting the stone 11 in a position 90° from the flattened distal end which fits the saw chuck, which would thus be perpendicular. The claimed invention involves not a configuration that is perpendicular, but one which is parallel. The figures the Examiner relies upon do not adequately show whether the attachment device contains bends, but as only a 90° configuration is discussed in both the specification and claims of Harris, it cannot be assumed that any other configuration other than 90° is disclosed or implied. Furthermore, the Harris patent lacks antecedent basis for several elements, such as the flattened distal end, the supporting portion and the holding device. Because of these deficiencies, it is uncertain what the limitations of the Harris patent are, making it unsuitable for use as prior art, and a rejection under 35 U.S.C. 103(a) is improper.

Regarding claims 4-6, the Examiner states that Barnes, as modified by Harris, teaches all the limitations of the claimed invention, i.e., substantially rectangular sanding strips; tab with U-shaped slot, except using a metal strip for the sanding end. However, the Examiner states that using rigid abrasives depending on the intended use is well known within the knowledge of one of ordinary skill in the art. While rigid abrasives may be known in the art, such abrasives are generally removable, as they lose their abrasive qualities over time. In fact, Barnes specifically teaches away from fixed abrasive surfaces, instead utilizing a removable adhesive backing to the abrasive sheet material (Barnes col. 3, lines 51-64). By contrast, the sanding strip of the claimed invention is not removable from the sanding end (claim 7). Additionally, Harris teaches that the sharpening stone is bonded to the holding device (col. 2, lines 5-8). While nowhere in the patent does Harris discuss what is a "suitable bonding," bonding generally means either a chemical bond, or a substance or agent that causes two or more objects or parts to cohere. Conversely, the claimed invention utilized purely mechanical attachment methods, such as rivets, welding and screws (claim 7). Chemical and mechanical attachments are not achieved in substantially the same way, and should not be considered equivalents. Graver Tank & Mfg. Co. v. Linde Air Products Co.,

339 U.S. 605 (1950). Furthermore, the sharpening device of Harris is substantially different from the claimed invention, as the nature of an abrasive sharpening device is inherently different than an abrading surface. Specifically, a sharpening device is meant to precisely hone the edge of a tool, whereas an abrasive is meant to be used on a tool to remove a secondary material. Therefore, Harris also fails the third criterion of a *prima facie* showing of obviousness, in that one of ordinary skill in the art would not have a motivation to look to sharpening devices for an attachment method of an abrasive strip for sanding. Because the prior art of Barnes teaches away from the claimed invention, and Harris does not teach every limitation of the claimed attachment method, and there is no motivation to combine the attachment method of Harris, the combination of Barnes and Harris fails to satisfy the first and third criteria of a *prima facie* showing of obviousness, and a rejection under 35 U.S.C. 103(a) is improper. Claim 6 has been cancelled without prejudice, thus the Examiner's rejection to this claim has been obviated.

Regarding claims 7 and 8, the Examiner states that Barnes, as modified by Harris and further modified in view of preferred choice of material for the intended use as in claim 4, meets all the limitations except the means of attaching the strip to the

blade, but it discloses a detachable means for the abrasives and using rigid abrasives, e.g., screws. The Examiner states that attaching the strip to the blade via detachable means is within the knowledge of one of ordinary skill in the art. As stated above, the sanding strip attachment method of the claimed invention is not meant to be detachable, even though screws are used. Therefore, the fact that the prior art teaches towards detachable abrasive strips, and away from rigid, non-removable strips, further evidences the non-obviousness of the claimed invention. For these reasons, a rejection under 35 U.S.C. 103(a) is improper.

Regarding claims 9 and 10-12, the Examiner states that Barnes, as modified by Harris further modified as in claim 7, meets all the limitations except for chamfered corners, however, rounding or chamfering the corners, for safety reasons, is within the knowledge of one of ordinary skill in the art, meeting all the limitations of claims 10 and 11. The Examiner further states that use of a rigid sanding strip made of metal is a modification within the knowledge of one of ordinary skill in the art and because it has been held to be within the general skill of a worker to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re*

Leshin, 125 USPQ 416. Claims 9, 10, 11 and 12 have been cancelled without prejudice, thus the Examiner's rejection has been obviated.

Regarding claim 13, the Examiner states Barnes, as modified by Harris, meets the limitations, i.e., variety of shapes. Claim 13 has been cancelled without prejudice, thus the Examiner's rejection has been obviated.

The Examiner has also rejected claims 4-13 under 35 U.S.C. 103(a) as being unpatentable over Romagnoli. Reconsideration and withdrawal of these rejections are respectfully requested.

As already discussed, there are in general, three basic criteria that must be satisfied in order to establish a prima facie case of obviousness (M.P.E.P. § 706.02(j)). First, the reference or combination of references must teach or suggest all of the claim limitations. Second, there must be reasonable expectation of success. Third, there must be some suggestion of motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. The rejection of

claims 3-13 based upon Barnes in view of Harris fail to satisfy the first criteria of a *prima facie* showing of obviousness.

Regarding claim 4, the Examiner states that Romagnoli meets all the limitations of claim 4 except for disclosing the rectangular shape of a metal sanding surface. Claim 4 has been cancelled without prejudice, thus the Examiner's rejection has been obviated.

Regarding claim 5, the Examiner states that Romagnoli as modified meets all of the limitations. This rejection fails to satisfy the first criteria of the standard for an obviousness rejection. Specifically, Romagnoli does not teach or suggest all of the claim limitations of the present application. Romagnoli does not claim or reference "small, raised protuberances for rapidly abrading a rough surface." Romagnoli teaches various embodiments of a cutting blade, rather than a sanding attachment. While Romagnoli teaches "an abrasive joined to the blade, such as carbide steel granules," it does not claim this feature and it teaches this merely as an embodiment for a *cutting* blade, not a *sanding* attachment. Therefore, Romagnoli does not teach or suggest all the limitations of the present claim 5. Further, a cutting blade with metal granules would leave a rough hewn

surface, as opposed to a smoothed surface, which is the desired result of the present invention. Thus the suggested embodiment of Romagnoli actually teaches away from the present invention.

Regarding claim 6, the Examiner states that Romagnoli, as modified, meets all of the limitations except disclosing a U-shaped slot in the tab (44). Claim 6 has been cancelled without prejudice, thus the Examiner's rejection has been obviated.

Regarding claim 7, the Examiner states that Romagnoli, as modified, meets all the limitations except for disclosing the means of attaching the strip to the blade, which the Examiner states is an obvious modification. As discussed above, the prior art teaches away from fixed, mechanical attachment methods. The prior art merely teaches either removable or chemical attachment methods, which, as already discussed, are not equivalent to the mechanical attachment achieved via rivets, screws or welding of the claimed invention. As the prior art teaches away from the claimed attachment method, a rejection under 35 U.S.C. 103(a) is improper.

Regarding claims 8-13, the Examiner states that Romagnoli, as modified, meets the limitations, e.g., substantially rectangular

(e.g., Fig. 1 or 4); rounded corners e.g., 32, 36; steel material 05:37; toothed blade 66; variety of shape and sizes depending on intended use. These rejections are respectfully but strenuously traversed for the reasons set forth in detail below.

Regarding claim 8, nowhere in Romagnoli is disclosed or suggested that the cutting edge is substantially rectangular. Romagnoli therefore fails to include every limitation of the claimed invention, and a rejection under 35 U.S.C. 103(a) is improper. Claims 9-13 have been cancelled without prejudice, thus the Examiner's rejections have been obviated.

In view of the above, reconsideration and allowance of the pending claims are respectfully solicited. Please remove the rejections under 35 U.S.C. 112, second paragraph, 35 U.S.C. 102(b) and 103(a), and enter the allowance of claims 1, 3-13. The applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



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